

preliminary examination report issued by the Authority. If no search is to be carried out the search examiner will complete Form PCT/ISA/203 (Declaration of Non-Establishment of International Search Report). As a general principle, a search is to be carried out wherever practicable.

9.04 The following paragraphs relate to subjects that may be excluded from international search or preliminary examination according to Rules 39 and 67. Practices differ among the Authorities regarding the exclusions issue. Some Authorities use an approach involving a “practical application” while others use an approach involving a “technical character.” Each Authority may use the approach that is consistent with its own practice. Paragraphs 9.05, 9.07 and 9.11 to 9.15 use both terms to accommodate these alternative practices. For the purposes of these paragraphs, the term “practical application” should be understood to mean a characteristic that the claimed invention, when viewed as a whole, has a practical application providing a useful, concrete and tangible result. “Technical character” should be understood to mean that the claimed invention must relate to a technical field, must be concerned with a technical problem and must have technical features in terms of which the matter for which protection is sought can be defined in the claim. However, it is noted that paragraphs 9.06 and 9.08 to 9.10, below, relate to exclusions that are not affected by these alternative practices.

*Scientific and Mathematical Theories*

*Rules 39.1(i), 67.1(i)*

9.05 The mere presence of scientific or mathematical theories in claims does not immediately exclude the claims from search or preliminary examination. When viewing the claims as a whole, if the theories are applied or implemented to produce a practical application or to have technical character, search and preliminary examination is required since the result is not purely abstract or intellectual. Scientific theories are a more generalized form of discoveries. For example, the physical theory of semi-conductivity would be excluded, whereas new semiconductor devices and processes for manufacturing would require search and preliminary examination. Mathematical theories are a particular example of the principle that purely abstract or intellectual methods are excluded. For example, a shortcut method of division would be excluded but a calculating machine designed to operate accordingly would require search and preliminary examination.

*Plant or Animal Varieties or Essentially Biological Processes for the Production of Plants and Animals, Other Than Microbiological Processes*

*Rules 39.1(ii), 67.1(ii)*

9.06 While plant and animal varieties may be excluded from search, transgenic plants and genetically modified non-human animals, as well as methods of making these types of inventions would be searched and examined. The question whether a process is “essentially biological” is one of degree, depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be excluded. For example, a method of selectively breeding horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological. However, a method of treating a plant characterized by the application of a growth-stimulating substance or radiation would not be essentially biological since, although a biological process is involved, the essence of the claimed invention is technical. Similarly, methods of cloning or genetically manipulating non-human animals are not essentially biological processes and would be searched and examined. The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded. The exclusion